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## NOTICE OF ALLOWANCE AND FEE(S) DUE

4372 7590 11/12/2008

ARENT FOX LLP  
1050 CONNECTICUT AVENUE, N.W.  
SUITE 400  
WASHINGTON, DC 20036

EXAMINER

SHAH, AMEE A

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 11/12/2008

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/441,892

11/17/1999

John S. Hendricks

026880.00011

5151

TITLE OF INVENTION: ELECTRONIC BOOK HAVING ELECTRONIC COMMERCE FEATURES

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1510	\$0	\$0	\$1510	02/12/2009

**THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.**

**THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.**

### HOW TO REPLY TO THIS NOTICE:

#### I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.**

# **PART B - FEE(S) TRANSMITTAL**

**Complete and send this form, together with applicable fee(s), to: Mail Mail Stop ISSUE FEE  
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P.O. Box 1450  
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**INSTRUCTIONS:** This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

4372 7590 11/12/2008  
**ARENT FOX LLP**  
1050 CONNECTICUT AVENUE, N.W.  
SUITE 400  
WASHINGTON, DC 20036

## **Certificate of Mailing or Transmission**

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,892	11/17/1999	John S. Hendricks	026880.00011	5151

TITLE OF INVENTION: ELECTRONIC BOOK HAVING ELECTRONIC COMMERCE FEATURES

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1510	\$0	\$0	\$1510	02/12/2009

EXAMINER	ART UNIT	CLASS-SUBCLASS
SHAH, AMEE A	3625	705-026000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

- ☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
- ☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list

- (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, 1 \_\_\_\_\_
- (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed. 2 \_\_\_\_\_
- 3 \_\_\_\_\_

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE (B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent) : ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. The following fee(s) are submitted:

- ☐ Issue Fee
- ☐ Publication Fee (No small entity discount permitted)
- ☐ Advance Order - # of Copies \_\_\_\_\_

4b. Payment of Fee(s); (Please first reapply any previously paid issue fee shown above)

- ☐ A check is enclosed.
- ☐ Payment by credit card. Form PTO-2038 is attached.
- ☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number \_\_\_\_\_ (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

- ☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. ☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature \_\_\_\_\_

Date \_\_\_\_\_

Typed or printed name \_\_\_\_\_

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This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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09/441,892	11/17/1999	John S. Hendricks	026880.00011	5151
4372	7590	11/12/2008	EXAMINER	
ARENT FOX LLP 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			SHAH, AMEE A	
			ART UNIT	PAPER NUMBER
			3625	
			DATE MAILED: 11/12/2008	

## Determination of Patent Term Extension under 35 U.S.C. 154 (b)

(application filed after June 7, 1995 but prior to May 29, 2000)

The Patent Term Extension is 0 day(s). Any patent to issue from the above-identified application will include an indication of the 0 day extension on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Extension is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

<b>Notice of Allowability</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/441,892	HENDRICKS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	AMEE A. SHAH	3625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to RCE of 7/29/08 & Ex. Amdt 10/14/08.
2. ☒ The allowed claim(s) is/are 1-19,22-33,42-74 and 89-106.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

**Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).**
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |  |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 5. <input type="checkbox"/> Notice of Informal Patent Application                      |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO/SB/08),<br>Paper No./Mail Date <u>7/29/08</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                    |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material                  | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance   |
|   | 9. <input type="checkbox"/> Other _____.   |

/Jeffrey A. Smith/  
Supervisory Patent Examiner, Art Unit 3625

### **DETAILED ACTION**

Claims 1-19, 22-33, 42-74 and 89-106 are pending in this action.

### **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

Claim 99. (Currently amended). The ~~method~~ apparatus of claim 42, wherein the presentation module further displays an available sample associated with the selective product or service upon a request from the user before the user requests to purchase the selected product or service.

### **REASONS FOR ALLOWANCE**

Claims 1-19, 22-33, 42-74 and 89-106 are allowable.

The following is an examiner's statement of reasons for allowance:

#### **Claim 1**

The prior art of record neither anticipates nor fairly and reasonably renders obvious the method of claim 1 for providing electronic commerce using an electronic book, comprising displaying an electronic book, presenting associated with the electronic book an identification of a product or service, receiving a user's selection of the product or service, performing a transaction to execute the purchase request, generating a table for the product and service of each user to record statistical information concerning purchases and requests for information concerning particular products and services, wherein the statistical information is used for selecting particular advertisements for display to the user, providing an electronic catalog identifying products and services to be accessed by the user, wherein the electronic catalog includes a default catalog and a customer catalog, the customer catalog being determined based upon identification of products and services previously purchased or for which information was requested, and displaying the default catalog to the user when there is no record of identification of products and services, wherein the performing step including allowing the user to submit an offered price and determining whether to accept the offered price based upon at least one of the following criteria: an amount of the offered price, any available rebates relating to the selected product or service, any available discounts relating to the selected product or service, or a range of acceptable prices for the selected product or service.

The prior art taken together fails to anticipate or reasonably and fairly render obvious the entirety of claim 1 as a whole.

A remarkable prior art, recited in previous office actions, is Hoffman et al., US 2005/0144133 A1 (hereafter referred to as "Hoffman") which teaches a method for providing

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electronic commerce using an electronic book comprising displaying an electronic book and presenting associated with the electronic book an identification of a product or service so that the user can purchase, i.e. perform a transaction for, the selected product or service (e.g. ¶¶0190-0192 and 0200). Hoffman also teaches storing data for each user to record statistical information and using such data, i.e. history, to determine which product images to insert (e.g. ¶¶0168-0174 and 0192). Hoffman further teaches generating and presenting a customized electronic catalog, including the identification of the product or service and an identification of other products or services, based upon information related to the user (Hoffman, ¶¶0198-0200).

Hoffman, however, does not teach wherein the performing of the transaction includes receiving an offered price from the user, determining whether to accept the offered price, selectively transmitting an indication, receiving a new offered price from the user, generating a table for the product or service and using that information to select particular advertisements, providing an electronic catalog identifying products and services to be accessed by the user, wherein the electronic catalog includes a default catalog and a customer catalog, the customer catalog being determined based upon identification of products and services previously purchased or for which information was requested, and displaying the default catalog to the user when there is no record of identification of products and services.

Another remarkable prior art, recited in previous office actions, is Aggarwal et al., US 6,885,000 B1 (hereafter referred to as "Aggarwal") which teaches a method for providing electronic commerce comprising displaying a product (col. 5, lines 39-47); presenting

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identification of a product or service associated with item A (col. 5, lines 47-51, and col. 6, lines 1-8); receiving a user's selection of the product or service and a request to purchase the selected product or service (col. 5, lines 45-47 and col. 6, lines 8-9); and performing a transaction to execute the purchase request, wherein the performing step includes: receiving from the user an offered price for the product or service (col. 6, lines 8-9); determining whether to accept the offered price (col. 6, lines 11-16); selectively transmitting an indication of an acceptance of the offered price based upon the determining (col. 6, lines 13-15 and 19-21); and receiving from the user one or more new offered prices if the offered price is not acceptable upon the determining (col. 6, lines 26-34), wherein the determining step includes determining whether to accept the offered price based upon at least one of the following criteria: an amount of the offered price, any available rebates relating to the selected product or service, any available discounts relating to the selected product or service, or a range of acceptable prices for the selected product or service (col. 6, lines 19-34 – note the determination is made based on the offered price and a range of acceptable price based on the user's profile). Aggarwal further teaches generating and presenting a customized electronic catalog, including the identification of the product or service and an identification of other products or services, based upon information related to the user (col. 5, line 45 through col. 6, line 17).

However, Aggarwal fails to cure the other deficiencies of Hoffman and does not teach providing an electronic catalog identifying products and services to be accessed by the user, wherein the electronic catalog includes a default catalog and a customer catalog, the customer catalog being determined based upon identification of products and services previously



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purchased or for which information was requested, and displaying the default catalog to the user when there is no record of identification of products and services.

Another remarkable prior art, cited in previous office actions is Kanevsky et al., US 6,334,109 B1 (hereafter referred to as “Kanevsky”) which teaches a method and system for distributing personalized advertisements including generating a database, i.e. a table, for each user to record statistical information, i.e. a product and user history (e.g. col. 10, lines 6-22).

However, Kanevsky fails to cure the other deficiencies of Hoffman and does not teach providing an electronic catalog identifying products and services to be accessed by the user, wherein the electronic catalog includes a default catalog and a customer catalog, the customer catalog being determined based upon identification of products and services previously purchased or for which information was requested, and displaying the default catalog to the user when there is no record of identification of products and services.

Another remarkable art, newly cited, is Sandrick, Karen, “Internet Marketing: Software for the Hard Sell,” Health Management Technology, Oct. 1998, vol. 19, no. 11, p. 16, which teaches a system and method wherein suppliers would create catalogs customized for individual purchasers based on the products the purchaser buys. However, Sandrick fails to cure the other deficiencies of the prior art.

The prior art, taken together, fails to anticipate or reasonably and fairly teach the method of claim 1 taken as a whole.

**Claims 2-33, 98, 103 and 105.**

Claims 2-33, 98, 103 and 105 are dependencies of independent claim 1 and are allowable over the prior art for the reasons identified above with respect to claim 1.

**Claims 89 and 97.**

Claims 89 and 97 recites methods for providing electronic commerce using an electronic book with steps similar to, consistent with and parallel to the limitations of claim 1, with some additional limitations. These methods are allowable over the prior art for reasons consistent with those identified above with response to claim 1.

**Claims 90-92, 100, 102 and 104.**

Claims 90-92, 100, 102 and 104 are dependencies of independent claims 89 and 97 and are allowable over the prior art for the reasons identified above with respect to claims 89 and 97.

**Claims 42 and 93.**

Claims 89 and 97 recites apparatuses for providing electronic commerce using an electronic book with functions similar to, consistent with and parallel to the limitations of claim 1. The apparatuses are interpreted to be statutory under 35 USC §101 as comprising hardware and software because the specification anticipates the modules of claims 89 and 97 to be hardware (such as a display and processor) and executable code (e.g. Specification, pages 9-10). These apparatuses are allowable over the prior art for reasons consistent with those identified above with response to claim 1.

**Claims 43-74, 94-96, 99, 101 and 106.**

Claims 43-74, 94-96, 99, 101 and 106 are dependencies of independent claims 42 and 93 and are allowable over the prior art for the reasons identified above with respect to claims 42 and 93.

**EXAMINER'S COMMENT**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 29, 2008, has been entered.

**CONCLUSION**

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMEE A. SHAH whose telephone number is (571)272-8116. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Smith/  
Supervisory Patent Examiner, Art Unit  
3625

AAS

October 14, 2008